



29 APR 2004

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In re Application of:
THOM, Volkmar, et al.
U.S. Application No.: 09/913,944
PCT No.: PCT/DK00/00065
International Filing Date: 17 February 2000
Priority Date: 17 February 1999
Atty Docket No.: P405 US00
For: BIOCOMPATIBLE MATERIAL
WITH A NOVEL FUNCTIONALITY

DECISION ON PETITION TO
VACATE HOLDING OF
ABANDONMENT
(37 CFR 1.8(b) and 1.181)

This decision is issued in response to the "Petition Under 37 CFR 1.8 And 1.181 To Vacate Erroneous Holding Of Abandonment" filed 12 March 2004. No petition fee is required.

BACKGROUND

On 17 February 2000, applicants filed international application PCT/DK00/00065 which claimed a priority date of 17 February 1999 and which designated the United States. On 24 August 2000, a copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) by the International Bureau (IB). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 17 August 2001.

On 17 August 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee. The attorneys who filed the national stage application were with the law firm of Skadden, Arps, Slate, Meagher & Flom ("Skadden Arps").

On 19 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed to the Skadden Arps address a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that a declaration acceptable under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required.

On 19 June 2003, the DO/EO/US mailed to the Skadden Arps address a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification Of Missing Requirements.

On 03 October 2003, a Power Of Attorney was filed by the assignee herein appointing above-named counsel.

On 12 March 2004, applicants filed the petition considered herein. The petition asserts that a response to the Notification Of Missing Requirements was timely filed by the Skadden Arps firm on 19 December 2001, that such response bore a certificate of mailing under 37 CFR 1.8, and that, based on the timely filing of this response, the holding of abandonment herein should be withdrawn.

DISCUSSION

The "Response To Notification Of Missing Requirements" and the declaration attached thereto are not present in the application file. The failure of the USPTO to receive these materials resulted in the abandonment of the application. A review of the Response To Notification Of Missing Requirements" reveals that it contains an executed Certificate Of Mailing in compliance with 37 CFR 1.8(a); the Certificate Of Mailing states that the materials were deposited as first class mail on 19 December 2001, before the expiration of the two month response period set forth in the Notification Of Missing Requirements.

Where, as here, correspondence mailed in accordance with 37 CFR 1.8(a) was not received in the USPTO and abandonment results, 37 CFR 1.8(b) states that such correspondence will be considered timely if the mailing party satisfies the following three requirements:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission.

Based on counsel's statements in the present petition, the accompanying Declaration Of Josephine Hardy,¹ and the submission of a copy of the Response To Notification Of Missing Requirements (and the executed inventors' declaration attached thereto), it is concluded that applicants have satisfied the requirements of 37 CFR 1.8(b). Accordingly, the Response To Notification Of Missing Requirements and the attached declaration will be treated as a timely response to the Notification Of Missing Requirements mailed 19 October 2001. It is noted, that for all purpose other than timeliness, these materials will be treated as having been filed on 12 March 2004, the date the present petition was filed.

The Notification Of Abandonment mailed 19 June 2003, based as it was on applicants' purported failure to file a timely response to the Notification Of Missing Requirements, is appropriately vacated.

A review of the declaration attached to the petition confirms that the declaration is in compliance with 37 CFR 1.497.

¹ Josephine Hardy is the legal assistant at the Skadden Arps firm who mailed the response materials and who executed the Certificate of Mailing contained thereon.

CONCLUSION

Applicants' petition under 37 CFR 1.8(b) and 1.181 is **GRANTED**.

The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 19 June 2003 is hereby **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 12 March 2004.



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